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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,535	09/12/2003	Tsutomu Ohishi	242744US2	5332
22850	7590	03/12/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER	
			POPOVICT, DOV	
			ART UNIT	PAPER NUMBER
			2625	
			NOTIFICATION DATE	DELIVERY MODE
			03/12/2009	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/660,535

Applicant(s)

OHISHI ET AL.

Examiner

Dov Popovici

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 12/23/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/23/2008 has been entered.

Remarks

Ohishi et al. (US 2003/0133136 A1), Ohishi et al. (US 2003/0218765 A1), Akiyoshi et al. (US 2004/0218208A1), Ohishi et al. (US 2004/0057074 A1), Ohishi et al. (US 2004/0057067 A1), Hirai et al. (US 2004/0021890 A1), Tanaka (US 2003/0072023 A1), Akiyoshi et al. (US 2004/0075857) and Akiyoshi (US 7,280,238 B2) are cited as relevant prior art for teaching the same subject matter (at least with respect to the independent claims 1, 10, 19 and 20) as taught by Ohishi et al. (US 2003/0140174 A1) used in the rejection. If applicant files a statement under 35 USC 103(c) to say that the reference is commonly owned at the time the invention was made, applicant should make sure that the statement applies to all the above cited references. If applicant files a statement to overcome the rejection under 35 USC 103(a) or to disqualify the

reference under 35 USC 103(c), applicant should make sure that the statement(s) applies to all of the above cited references as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being obvious over Ohishi et al. (US 2003/0140174 A1) in view Kajita et al. (U.S. Patent No. 6,069,706).

The applied reference has a common assignee or at least one common inventor or inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104,

together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

As to claim 1, Ohishi et al. (US 2003/0140174 A1) discloses an image forming apparatus (see figure 3) comprising an operation panel (410) and hardware resources (303) used for image formation including a scanner engine (see paragraph 0049), an application (330), and a platform (320) that exists between the application (330) and the hardware resources (303), the platform (320) including an OS (321) and at least one control service (3) to control an execution of each requested processing of the hardware resources (303) according to a function call from the application, wherein interprocess communication (503) is performed between the control service and the application.

Ohishi et al. does not teach wherein the application causing the image forming apparatus to function as: a display part configured to display a selection screen for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel; a scanning process part configured to cause the scanner engine to scan a document to produce scanned data; a transfer part configured to transfer the scanned data to one or more selected transfer destinations; and a print process part configured to receive the scanned data from a storing area of the selected transfer destination and print the scanned data.

Kajita et al. discloses an image forming apparatus (see figure 24) having an application for causing the image forming apparatus (see figure 24) to function as: a

display part (see figures 24-38) configured to display a selection screen (see figures 30-31) for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel (see figure 33, scan processing, where a computer is selected S1002, original is read S1009, and image data and file name is transferred S1016); a scanning process part configured to cause the scanner engine (315) to scan a document to produce scanned data; a transfer part (see figures 32-33) configured to transfer the scanned data to one or more selected transfer destinations; and a print process part (317 and see figures 26 and 28-29) configured to receive the scanned data from a storing area of the selected transfer destination and print the scanned data (see column 21, lines 42-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Ohishi et al. wherein: the application causing the image forming apparatus to function as: a display part configured to display a selection screen for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel; a scanning process part configured to cause the scanner engine to scan a document to produce scanned data; a transfer part configured to transfer the scanned data to one or more selected transfer destinations; and a print process part configured to receive the scanned data from a storing area of the selected transfer destination and print the scanned data.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Ohishi et al. by the teaching of Kajita et al. so that the application can cause the image forming apparatus to function as: a display part

configured to display a selection screen for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel; a scanning process part configured to cause the scanner engine to scan a document to produce scanned data; a transfer part configured to transfer the scanned data to one or more selected transfer destinations; and a print process part configured to receive the scanned data from a storing area of the selected transfer destination and print the scanned data. The motivation and/or rational to combine Ohishi et al. and Kajita et al. is mainly so that scanned data can be transferred to other destinations or locations among the network, for example, to be displayed at a user computer's screen display or laptop display for viewing by the user when ever needed, and so that the scanned data can be transferred to other destinations or locations within or on the network or other connected networks, for the purpose of storing the scanned data at remote storage locations on the network (i.e., storage at other locations on the network), displaying the scanned data to user(s) on the network, and/or printing the scanned data at a later time or when ever it is needed.

As to claim 2, Ohishi et al. as modified discloses wherein the one or more selected transfer destinations include one or more of a storing area on a web server on a network, a mail destination, and a shared area on a network (see Kajita et al., see figures 24-38 and col. 22, lines 49-67 and see col. 21, lines 42-55).

As to claim 3, Ohishi et al. as modified discloses wherein, if authentication information is required (see Kajita et al., reads on password 704 see figure 30) for accessing the storing area or the shared storing area, the display part displays a screen

for inputting the authentication information (password 704) when the storing area or the shared storing area is selected.

As to claim 4, Ohishi et al. as modified discloses wherein the display part displays a screen for selecting a data type of scanned data to be transferred among from a plurality of data types, and the transfer part converts the scanned data into data of the data type, and transfers the data of the data type (see Kajita et al., figures 26 and 33-34 and see Ohishi et al. figure 16).

As to claim 5, Ohishi et al. as modified discloses wherein the plurality of data types include a type of recognized data that is obtained by performing character recognition process on the scanned data (see Ohishi et al. paragraph 0106).

As to claim 6, Ohishi et al. as modified discloses wherein, when the recognized data is selected as a data type, the transfer part sends the recognized data and the scanned data to a transfer destination (see Kajita et al., see figures 24-38 and col. 22, lines 49-67 and see col. 21, lines 42-55).

As to claim 8, Ohishi et al. as modified discloses wherein the print process part displays, on the operation panel, a data selection screen for displaying a list of scanned data stored in the storing area, and prints scanned data selected from the list (see Kajita et al., figures 28-29 and 31-32).

As to claim 9, Ohishi et al. as modified discloses the image forming apparatus further comprising hardware resources (303) used for image forming processes, and control services (3) that perform processes of the system side including control of the hardware resources (303) according to a request from an application (2), wherein

the image forming apparatus is configured so as to be able to install a plurality of applications (see figure 3) separately from the control services, and the image forming apparatus includes the scanning process part, the display part and the transfer part as an application (see Kajita et al. see figures 24-38).

Claims 10-15 and 17-20 recite the same and/or similar claim limitations or features as recited in claims 1-6 and 8-9 above. Therefore, claims 10-15 and 17-20 are rejected similarly as claims 1-6 and 8-9 above, for the same or similar reasons as stated above. Applicant is directed to the remarks and the discussion made in claims 1-6 and 8-9 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ohishi et al. (US 2003/0133136 A1), Ohishi et al. (US 2003/0218765 A1), Akiyoshi et al. (US 2004/0218208A1), Ohishi et al. (US 2004/0057074 A1), Ohishi et al. (US 2004/0057067 A1), Hirai et al. (US 2004/0021890 A1), Tanaka (US 2003/0072023 A1), Akiyoshi et al. (US 2004/0075857) and Akiyoshi (US 7,280,238 B2) are cited as relevant prior art for teaching the same subject matter (at least with respect to the independent claims 1, 10, 19 and 20) as taught by Ohishi et al. (US 2003/0140174 A1) used in the rejection above. If applicant files a statement under 35 USC 103C to say that the reference is commonly owned at the time the invention was made, applicant should make sure that the statement applies to all the above cited references. If

applicant files a statement to overcome the rejection under 35 USC 103(a) or to disqualify the reference under 35 USC 103(c), applicant should make sure that the statement(s) applies to all of the above cited references as well.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dov Popovici/
Primary Examiner, Art Unit 2625